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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,956	02/05/2001	Jared Schutz	Proflowers -P1-01	2313
7590 Peter K. Trzyna P.O. Box 7131 Chicago, IL 60680			EXAMINER PHAM, THIERRY L	
			ART UNIT 2625	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/26/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/776,956

Applicant(s)

SCHUTZ ET AL.

Examiner

Thierry L. Pham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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### **DETAILED ACTION**

- This action is responsive to the following communication: Amendment and Declaration of prior invention filed on 12/4/06.
- Claims 1-28 are currently pending.

### **AFFIDAVIT & DECLARATION**

The declaration filed on 12/4/06 under 37 CFR 1.131 is sufficient to overcome the US 6206750 to Barad and US 5984778 to Murphy references. Note: current application claims priority (CIP) to s/n 09149650 with effective filing date of 9/8/1998, therefore, US 5984778 to Murphy is a 102(e) reference rather than 102(b) reference as stated in Office Action dated 6/2/06. In conclusion, declaration of prior invention filed on 12/4/06 effectively overcomes these cited prior art references (US 6206750 & US 5984778).

### ***Response to Arguments***

The declaration filed on 12/4/06 under 37 CFR 1.131 is sufficient to overcome the US 6206750 to Barad and US 5984778 to Murphy references. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art references.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 8-25, 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Laurush et al (US 5413383).

Regarding claim 1, Laurush discloses a method including:

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- forming, from a single sheet (fig. 1), at least two of a carrier waybill area (middle panel, fig. 1), a packing list area (upper panel, fig. 1), and customizable component area, wherein
- if one of the at least two areas include the carrier waybill area, printing a carrier waybill on the carrier waybill area (middle panel, fig. 1),
- if one of the at least two areas includes the packing list area, printing a packing list on the packing list area (upper panel, fig. 1), and
- if one of the at least two areas includes the customizable component area, printing a customizable component on the customizable component area.

Regarding claim 2, Laurush further discloses a method of claim 1, wherein the forming includes all of the areas (all three areas, figs. 2-9, col. 4, lines 49-58).

Regarding claim 8, Laurush further discloses the method of claim 1, wherein the forming includes demarking (demarking, fig. 1) indicative of separability of pieces to correspond to the at least two areas.

Regarding claim 9, Laurush further discloses the method of claim 1, wherein the forming includes perforating (perforating, fig. 1, col. 2, lines 10-11) indicative of separability of pieces to correspond to the at least two areas.

Regarding claim 10, Laurush further discloses the method of claim 1, wherein the at least two areas include the customizable component area and further including: combining the customizable component with goods in a package (col. 3, lines 58-60 and col. 5, lines 17-60); and shipping (col. 3, lines 58-60) the package in accordance with the carrier waybill.

Regarding claims 11-12, Laurush further discloses the method of claim 1, further including: combining a piece of the sheet comprised of one of the areas with goods in the

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package (col. 3, lines 58-60 and col. 5, lines 17-60), and shipping (col. 3, lines 58-60) the package.

Regarding claims 13-14, Laurush further discloses the method 1, further including: combining a piece of the sheet comprised of one of the areas with flowers (shipping label is for shipping consumer goods and services including flowers, col. 3, lines 58-60 and col. 5, lines 17-60) in a package, and shipping (consumer goods and/or services, col. 3, lines 58-60) the package.

Regarding claims 15-17, Laurush further discloses the method of claim 1, wherein the component (fig. 1) is comprised of a graphic and/or text (customizable information can be either text or graphic such as barcode, fig. 6).

Regarding claim 18, Laurush discloses a method including:

- forming multiple parts (multiple parts on a single sheet, fig. 1) from a sheet, the parts including at least two of a packing list (packing list, fig. 1), a customizable component, and a shipping sheet (shipping list, fig. 1);
- combining one (shipping label is to attached with package for shipping, fig. 1, col. 1, lines 5-8) of the at least two parts with a package, and
- shipping (fig. 1, col. 1, lines 5-8) the package.

Regarding claim 19, Laurush further discloses the method of claim 18, wherein the sheet is integral (fig. 1) during said printing the at least two of a packing list, a customizable component, and a shipping sheet.

Regarding claim 20, Laurush further discloses the method of claim 18, wherein the sheet is not integral (fig. 1) during said printing the at least two of a packing list, a customizable component, and a shipping sheet.

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Regarding claim 21, Laurush further discloses the method of claim 19, wherein the printing is facilitated by a TCP/IP communication (col. 2, lines 1-3).

Regarding claim 22, Laurush further discloses the method of claim 19, wherein the printing is facilitated by a TCP/IP communication (col. 2, lines 1-3).

Regarding claims 23-24, Laurush further discloses the method of claim 18, wherein the at least two parts include the shipping sheet, and the shipping sheet designates good (ref. 16, fig. 1) in the package.

Regarding claims 25 & 27, Laurush discloses a method including:

- forming a combination of a portion (printing multiple components shipping label 10 using printer, fig. 1, col. 1, lines 60-61) from a sheet with a package, the portion including at least one of a packing list, a customize component, and a shipping sheet (plurality of components, fig. 1); and
- shipping (fig. 1) the combination.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3-7, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laurush as described in claim 1 & 18 above, and in view of Bezos (US 5727163).

Regarding claim 3, Laurush teaches a system for transmitting customized digital message data from a host computer to a printer (col. 2, lines 1-4), but fails to teach and/or suggest a customized digital message is transmitted from a consumer ordering system.

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Bezos, in the same field of endeavor, teaches a well-known example of an Internet communication network that allows users/consumers to transmit customized digital message from a consumer ordering system to a merchant processing system (fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify network system of Laurush to include an Internet communication protocol that allows users/consumers to transmit digital message from consumer ordering system (e.g. customer's PC) to merchant processing system (e.g. supplier's PC) as taught by Bezos. Doing so, it improves purchase transaction more efficiently, for example, customer can instruct the merchant/supplier for special delivery instructions which can be printed on a shipping label (as taught by Laurush).

Therefore, it would have been obvious to combine Laurush with Bezos to obtain the invention as specified in claim 3.

Regarding claim 4, Bezos further teaches a method of communicating the message to a distribution center (fig. 1).

Regarding claims 5-7, and 26, Bezos further teaches a method of communicating the message to/from a courier shipping computer system, financial institutions (it is well known in the art that Internet communication network as shown in fig. 1 can be used to communicate digital message to any recipients worldwide including merchants, banks, hotels, package handler, shipper such as UPS, Fedex, USPS, and etc).

Regarding claim 28, Laurush further teaches a method for printing an ornamental design on the carrier waybill area (e.g. middle panel includes company logo, fig. 1, printing texts and graphics are well known in the art and can be implemented via using matrix printer as taught by Laurush).

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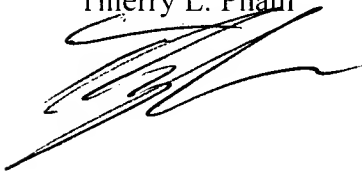
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 272-7439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thierry L. Pham



  
GABRIEL I. GARCIA  
PRIMARY EXAMINER